Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Noted
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Ex parte FRIEDHELM BECKMANN

Appeal No. 2004-2097
Application No. 09/501,013

ON BRIEF

Before PAK, OWENS, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2003) from the examiner's final rejection of claims 1 and 3 through 22 (final Office action mailed Dec. 23, 2002, paper 7) in the above-identified application.[1]

The subject matter on appeal relates to a sound and heat insulation material comprising a specified core layer and a specified covering layer. Further details of this appealed

subject matter are recited in representative claim 1, the sole independent claim on appeal, reproduced below:

> 1. A sound and heat insulation material, comprising:
> a core layer including fibrous material and having at least one outer surface, said fibrous material being provided with a fire retardant additive; and
> a covering layer including a foamable material covering said core layer at said at least one outer surface, said foamable material being at least difficult to ignite and foaming at a given temperature to insulate said core layer from high temperature and oxygen.

The examiner relies on the following prior art reference as evidence of unpatentability:

Murch	3,934,066	Jan. 20, 1976

Claims 1 and 3 through 22 on appeal stand rejected under 35 U.S.C. § 102(b) as anticipated by Murch. (Answer at 3-7.)

Because the examiner has not adequately established a prima facie case of anticipation against the appealed claims, we reverse.

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d

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[1] The final rejection of claim 2 has been expressly withdrawn. (Examiner's answer mailed Aug. 27, 2003, paper 12, p. 2.)

1429, 1431 (Fed. Cir. 1997). In addition, the prior art reference must disclose the limitations of the claimed invention "without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

Murch discloses a fire-retardant intumescent laminate system suitable for application to combustible or heat-sensitive substrates to protect such substrates from fire and heat. (Column 1, lines 5-8.) Specifically, Murch teaches an intumescent laminate system comprising an intumescent layer comprising a porous sheet material impregnated with an intumescent composition and a flexible protective layer adhered to the outer surface of the intumescent layer. (Column 2, lines 16-22.) According to Murch, "[t]he impregnated sheet material is any sufficiently porous adsorbent material which will absorb the intumescent composition." (Column 3,lines 50-52.) Regarding the protective cover layer, Murch discloses numerous materials including "well known waterproofed and flameproofed textile materials." (Column 7, line 55 to column 8, line 31.) Murch further teaches that "[t]he flexible protective cover may

comprise more than one layer of material which may be the same or different." (Column 8, lines 43-57.)

The examiner's position is that Murch's protective cover layer and the intumescent layer correspond to the here recited "core layer" and "covering layer," respectively, and that, therefore, Murch's intumescent laminate system anticipates the invention recited in appealed claim 1. (Answer at 6.) We cannot agree.

The examiner does not challenge the appellant's contention that the term "'core' is defined as '[a] central part of different character from what which surrounds it', '[t]he interior part of a wall or column'" with any other dictionary definition.[2] (Appeal brief filed Jul. 7, 2003, paper 11, pages 7-8.) Rather, the examiner argues (answer at 6):

> It is noted that the provided definition of core is inconsistent with Appellants' [sic] own claims. Independent claim 1 claims a material that comprises: a core layer having at least one outer surface and a covering layer covering the core layer at said at least one outer surface. The language used in the claims indicates two layers...

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[2] Cf. In re Morris, 127 F.3d 1048, 1055-56, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997) ("Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation.") (Emphasis added.).

While the examiner is correct that appealed claim 1 does not expressly recite a layer in addition to the specified "core layer" and "covering layer," the term "core" would be understood by one skilled in the relevant art that the claimed sound and heat insulation material must necessarily include at least a third layer next to the "core layer" on the surface opposite to which the "covering layer" is situated. It is by now axiomatic that every limitation or word in a claim must be considered in adjudging the propriety of a rejection based on prior art. In re Geerdes, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974) ("[E]very limitation in the claim must be given effect rather than considering one in isolation from the others."); In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

For these reasons, we reverse the examiner's rejection under 35 U.S.C. § 102(b) of appealed claims 1 and 3 through 22 as anticipated by Murch.[3]

[3] As we discussed above, Murch teaches that the flexible protective layer may comprise more than one layer. (Column 8, lines 43-46.) Thus, the appellant and the examiner may wish to

The decision of the examiner is reversed.

REVERSED

Chung K. Pak)
Administrative Patent Judge)
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Terry J. Owens) BOARD OF PATENT
Terry J. Owens)
Administrative Patent Judge) APPEALS AND
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) INTERFERENCES
Romulo H. Delmendo)
Romulo H. Delmendo)
Administrative Patent Judge)

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consider whether any or all of the appealed claims should be rejected under 35 U.S.C. § 103(a) as unpatentable over Murch.

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